



Docket No.: 50179-093

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of

Peter Laurence MOLLOY, et al.

Serial No.: 09 914,651

Group Art Unit: 1642

Filed: December 27, 2001

Examiner: Minh-Tam Davis

For: REGULATORY CONSTRUCTS COMPRISING INTRON 3 OF SPECIFIC
MEMBRANE ANTIGEN GENE

RESPONSE TO OFFICIAL ACTION

Mail Stop Restriction Requirement
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

MAY 27 2003

Sir:

TECH CENTER 1600/2900

This is in response to the Official Action of March 26, 2003 in this application. In the action, restriction was required between the inventions identified as those of Groups I-VI. In response to this requirement, Applicants elect the invention of Group I, directed to claims 54-78, and drawn to a recombinant polynucleotide or an expression cassette. This requirement for restriction is respectfully traversed and reconsideration is requested. In addition, the Examiner requires election with respect to any of the Groups I-VI and any one of the promoters cited in claims 57, 74, 90 or 100. In response to this requirement for election of species, Applicants elect the enhancer comprising nucleotides 14,045 to 16,575 and the promoter which is active in the prostate and recited in the indicated claims. This requirement for election is also respectfully traversed and reconsideration is requested.

Reconsideration of the requirement for restriction and election is respectfully requested. In reviewing the recitation in the Official Action, it is noted that the Examiner applies 35 USC 121, 37 CFR 1.141, and MPEP 806.05(h) to support the restriction and election requirement. However, Applicants believe this is in error since this application is a National Phase application filed through the provisions of the PCT. We believe that any restriction and election requirements must comply with National Stage requirements as set forth in 37 CFR 1.475 which states that a restriction or election requirement is improper if there is a special technical feature linking various claims in the application. Therefore, on this basis, the requirements for restriction and election are respectfully traversed and reconsideration is requested.

In particular, MPEP 1893.03 states: "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding technical feature". In the present case, we submit that all of the claims clearly share at least one common special technical feature. For example the isolated nucleic acid molecule defined in claim 79 (Group II claims) comprises a sequence which is a regulatory element derived from intron 3 of the PSM gene as defined in claim 54 (or Group I claims).

The Examiner has stated that the "products of groups I-II are patentably distinct from each other because they are drawn to entirely different biochemicals, having different structures. However, the nucleic acid sequences defined in Group II claims fall within the scope of the term "regulatory element derived from intron 3 of the PSM gene". Accordingly, these are not entirely different biochemicals as asserted by the Examiner.

Further, Groups III-VI relate to method claims which involve the use of regulatory element derived from intron 3 of the PSM gene.

It is believed that the above represents a complete response to the Official Action and reconsideration is now in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Robert L. Price
Registration No. 22,685

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 RLP:ajb
Facsimile: (202) 756-8087
Date: May 22, 2003